



BANNER & WITCOFF, LTD.
INTELLECTUAL PROPERTY LAW

RECEIVED
CENTRAL FAX CENTER 601 SW SECOND AVENUE, # 1900
PORTLAND, OREGON 97204

SEP 15 2005

TEL: 503.425.6800
FAX: 503.425.6801
www.bannerwitcoff.com

FACSIMILE TRANSMITTAL SHEET

To:	FROM:
Examiner Andrew J. Rudy	Thomas L. Evans
COMPANY:	DATE:
U.S.P.T.O.	September 15, 2005
FAX NUMBER:	TOTAL NO. OF PAGES:
571-273-8300	13
Re:	OUR REFERENCE No.:
U.S. Serial No. 10/099,685	005127.00033

If you do not receive all page(s) or have any problems receiving this transmission, please call:

NAME:	Lesa Wolman	PHONE:	503-425-6800
--------------	-------------	---------------	--------------

COMMENTS:

IMPORTANT/CONFIDENTIAL: This message is intended only for the use of the individual or entity to whom it is addressed. This message contains information from the law firm of BANNER & WITCOFF, LTD., which may be privileged, confidential or exempt from disclosure under applicable law. If the reader of this message is not the intended recipient, you are hereby notified that any dissemination, distribution, retention, archiving, or copying of the communication is strictly prohibited. If you have received this communication in error, please notify us immediately at our telephone number listed above. We will be happy to arrange for the return of this message to our offices at no cost to you.

CHICAGO

WASHINGTON, D.C.

BOSTON

**PORLAND,
OR**

PTO/SB/97 (05-03)

Approved for use through 04/30/2003. OMB 0651-0031

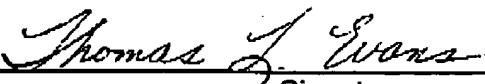
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Certificate of Transmission under 37 CFR 1.8

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office

on September 15, 2005.

Date



Signature

Thomas L. Evans, #35,805

Typed or printed name of person signing Certificate

Note: Each paper must have its own certificate of transmission, or this certificate must identify each submitted paper.

Appeal Brief (8 pages)

Response To Non-Compliant Appeal Brief (3 pages)

One Month Petition for Extension of Time (1 page)

Serial No. 10/099,685

Attorney Docket No. 005127.00033

This collection of information is required by 37 CFR 1.8. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1.8 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

RECEIVED
CENTRAL FAX CENTER

SEP 15 2005

Certificate Of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office at telephone number (571) 273-8300 on September 15, 2005.

Respectfully submitted,

By: Thomas L. Evans
Thomas L. Evans, Reg. No. 35,805
BANNER & WITCOFF, LTD.

Atty. Docket No.
005127.00033

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Daniel R. Potter et al.

Examiner: Andrew J. Rudy

U.S. Pat. App. No.: 10/099,685

Group Art Unit: 3627

Filed: March 14, 2002

For: CUSTOM FIT SALE OF FOOTWEAR

RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Notification Of Non-Compliance dated July 15, 2005, Appellant respectfully submits a revised Appeal Brief. A revised Appeal Brief was due by August 15, 2005. Accordingly, Appellant is concurrently submitting a Petition for a one month extension of time,

U.S. Pat. App. No.: 10/099,685
Atty. Docket No.: 005127.00033

together with authorization to charge the associated Petition fee, together with any other fees that may be necessary to maintain the pendency of this application, to Deposit Account No. 19-0733. Please consider this revised Appeal Brief as timely filed.

In the Notification, the Primary Examiner noted that the originally filed Appeal Brief was non-compliant because (i) the Brief did not present an argument under a separate heading for each ground of rejection on appeal, (ii) the summary of claimed subject matter was deficient with regards to the independent claims 10 as to specificity regarding page, line and drawing requirements, (iii) the heading to (iv) was missing, and (v) the Conclusion paragraph was extraneous and not in conformance with 37 C.F.R. §41.37. In a telephonic interview dated September 6, 2005, and a subsequent telephonic interview dated September 8, 2005, however, the Primary Examiner conceded that the summary of claimed subject matter in the original Appeal Brief was, in fact, compliant for specificity regarding page and line information. The Primary Examiner indicated that only references to drawings were missing from the description of the claimed subject matter in the original Appeal Brief. In addition, the Primary Examiner conceded that the Conclusion paragraph was not prohibited by 37 C.F.R. §41.37, and thus did not render the original Appeal Brief non-compliant.

Appellants have addressed the remaining minor issues raised by the Primary Examiner in the attached revised Appeal Brief. Appellants therefore ask for entry and consideration of the attached revised Appeal Brief, and invite the Primary Examiner's Reply at the Primary Examiner's earliest convenience.

U.S. Pat. App. No.: 10/099,685
Atty. Docket No.: 005127.00033

Respectfully submitted,

BANNER & WITCOFF, LTD.

By: Thomas L. Evans
Thomas L. Evans, Reg. No. 35,805
1001 G Street, N.W., 11th Floor
Washington, D.C. 20001-4597
Telephone: (503) 425-6800
Facsimile: (503) 425-6801

September 15, 2005

RECEIVED
CENTRAL FAX CENTER

SEP 15 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of

Daniel R. POTTER ET AL.

Serial Number 10/099,685

Filed: March 14, 2002

For: CUSTOM FIT SALE OF FOOTWEAR

Group Art Unit: 3627

Examiner: Andrew J. Rudy

Attorney Reference: 005127.00033

APPEAL BRIEF

Commissioner for Patents
U.S. Patent and Trademark Office
Alexandria, VA 22313

Sir:

Appellants hereby appeal to the Board of Patent Appeals and Interferences from a decision of the Primary Examiner finally rejecting claims 10-14 in the above-captioned patent application.

(1) Real Party In Interest

The real party in interest is Nike Corporation, a U.S. corporation having a place of business in Beaverton, Oregon.

(2) Related Appeals and Interferences

Appellants and their legal representatives are unaware of any appeals or interferences related to the subject appeal.

(3) Status of Claims

Claims 1-14 (reproduced for reference in the Claims Appendix) are pending in the application, with claims 1 and 10 being independent claims. Claims 1-9 were not elected in response to a restriction requirement, however, and thus were withdrawn from consideration. In a

final Office Action dated September 8, 2004, the Primary Examiner rejected each of elected claims 10-14.

(4) Status of Amendments

No amendments have been made to the claims following the final Office Action of September 8, 2004. In an effort to further prosecution of this application, Appellants submitted a Request For Consideration on March 10, 2005, but this Request did not present claim amendments.

(5) Summary Of Claimed Subject Matter

The claimed subject matter relates to a shoe distribution center for providing shoes to a plurality of customer. (See, e.g., the specification, paragraph 12, lines 1-2, and Figs. 1 and 4.) The shoe distribution center includes an order receiving unit. The order receiving unit receives footwear orders from customers through remote communication channels. (*Id.*, paragraph 18, lines 1-4, Figs. 1, 2 and 4.) The order will include various information identifying the desired footwear, including the particular model of footwear desired and the last by which the customer wishes to have the ordered shoes manufactured. (*Id.*, paragraph 30, lines 2-8, Fig. 3A.)

The shoe distribution center also includes a footwear inventory that contains one or more models of footwear in a variety of sizes. (*Id.*, paragraph 18, lines 4-6, Figs. 1 and 4). Each pair of footwear incorporates a moldable fit-component that allows each shoe to be remolded to lengths and widths differing from its original length and width. (*Id.*, paragraph 21, lines 1-6, Figs. 1 and 4).

Still further, the shoe distribution center includes a footwear manufacturing unit for remolding lengths and widths of pieces of footwear in the footwear inventory. (*Id.*, paragraph 18, lines 4-9, Figs. 1 and 4.) The footwear manufacturing unit remolds the lengths and widths of footwear ordered by a customer using the last identified in the customer's order. (*Id.*, paragraph 33, lines 1-5, Figs. 1, 2 and 4).

(6) Grounds Of Rejection To Be Reviewed On Appeal

The following grounds of rejection are presented to the Board of Patent Appeals and Interferences for review in this appeal:

- (a) Claims 10 and 11 have been rejected under 35 U.S.C. §103 over U.S. Patent No. 5,515,268 to Yoda in view of U.S. Patent No. 5,714,098 to Potter, and in further view of U.S. Patent No. 5,783,810 to Kelly, Jr.
- (b) Claims 12-14 have been rejected under 35 U.S.C. §103 over the combination of the Yoda, Potter, and Kelly, Jr. patents, and in further view of U.S. Patent No. 5,339,252 to White et al.

(7) Arguments

The Rejection Of Claims 10 And 11 Under 35 U.S.C. §103 Is Improper

The Primary Examiner rejected claims 10 and 11 under 35 U.S.C. §103 over U.S. Patent No. 5,515,268 to Yoda in view of U.S. Patent No. 5,714,098 to Potter, and in further view of U.S. Patent No. 5,783,810 to Kelly, Jr. Appellants respectfully traverse this rejection, and courteously ask for its reversal.

Appellants courteously urge that the Primary Examiner has not set forth a *prima facie* showing of obviousness necessary to sustain this rejection.

"A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." If the Examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. *In re Rijckaert*, 9 F.3d 1531, 20 U.S.P.Q.2d, 1955, 1956 (Fed. Cir. 1993).

Appellants submit that the Primary Examiner cannot have established the required *prima facie* showing of obviousness because *none of the cited prior art reference teach or suggest subject matter recited in the claims*.

Claims 10-14 recite "an order receiving unit that receives orders from customers for footwear to custom fit the customer, each order identifying at least one last." Thus, this claim recites an order receiving unit that allows customers to order footwear based upon a last shape rather than a conventional size/width combination.

These claims additionally recite "a footwear manufacturing unit for remolding lengths and widths of pieces of footwear in the footwear inventory using lasts identified in orders received by the order receiving unit." Accordingly, claims 10-14 recite manufacturing unit that manufactures footwear for a customer using the last specified in the customer's order.

Applicants respectfully point out that these features of the invention, while allowing a customer to order footwear according to a desired last, is not taught or suggested by any combination of the Yoda, Potter, and Kelly, Jr. patents. Thus, no combination of the Yoda, Potter et al. and Kelly, Jr. patents could suggest the subject matter recited in claims 10-14.

First, the Yoda patent discloses a method and system for ordering various products, such as footwear. With the method taught in the Yoda patent, a local sensor device detects a customer's body size information, and outputs this size information as body image of the customer rendered on a display. An image of a desired product is then superimposed over the body image. Based upon this superimposition, the customer decides whether the size of the desired product is appropriate. (See, e.g., Yoda, column 1, line 57 to column 2, line 13). Nothing in the Yoda patent would suggest custom-ordering footwear by identifying a specific last, as recited in claims 10-14, and the Primary Examiner has not argued otherwise.

Similarly, the Kelly, Jr. patent makes no mention of using last information to custom-order footwear. Instead, the Kelly, Jr. patent generally discloses an apparatus and method for tracking inventory of multiple goods in multiple shipping cartons.

The Potter et al. patent does describe a technique for custom-manufacturing footwear by remolding the footwear using a specific last. Notably, however, the Potter patent does not teach or suggest having the customer specify the last when requesting a pair of footwear. Potter instead describes having the customer try on sample footwear at a retail location. If the desired size is not in stock, then footwear with a similar size is remolded using a last. Thus, this patent likewise does not teach or suggest custom-ordering footwear by identifying a specific last and then having that footwear manufactured using the specified last.

As none of the Yoda, Potter, and Kelly, Jr. patents teach or suggest recited features of the invention, Appellants again urge that no combination of these documents could support a *prima facie* showing of obviousness required to sustain the outstanding rejection of claims 10 and 11 under 35 U.S.C. §103. Appellants therefore ask that this rejection be reversed.

The Rejection Of Claims 12-14 Under 35 U.S.C. §103 Is Improper

The Primary Examiner also rejected claims 12-14 under 35 U.S.C. §103 over the combination of the Yoda, Potter, and Kelly, Jr. patents, and in further view of U.S. Patent No. 5,339,252 to White et al. Appellants respectfully traverse this rejection, and courteously ask for

its reversal as well. Again, Appellants submit that the Primary Examiner has not set forth a *prima facie* showing of obviousness necessary to sustain this rejection.

As discussed in detail above, no combination of the Yoda, Potter, and Kelly, Jr. patents would teach or suggest the features of the invention recited in claims 12-14. Appellants urge that the White et al. patent does not remedy the omissions of the Yoda, Potter, and Kelly, Jr. patents.

The White et al. patent describes an integrated system for manufacturing lasts and footwear. According to the system described in the White et al. patent, however, a customer has his or her foot scanned to determine size information. This information is then used to create a last. Appellants therefore submit that the White et al. patent would actually teach away from custom-ordering footwear by specifying a last, as recited in claims 12-14.

Accordingly, Appellants respectfully submit that no combination of the Yoda, Potter, Kelly, Jr. and White et al. patents would teach or suggest recited features of the invention. It is therefore again urged that no combination of these documents thus could support a *prima facie* showing of obviousness required to sustain the outstanding rejection of claims 12-14 under 35 U.S.C. §103. Appellants therefore ask that this rejection be reversed

(8) Conclusion

The rejections submitted in the final Office Action of September 8, 2004 should be reversed for at least the reasons recited above. Allowance of claims 10-14 is, therefore, respectfully requested.

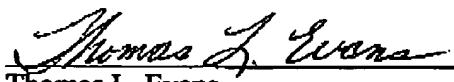
A Petition For A Two Month Extension Of Time was concurrently with the original presentation of this Appeal Brief. Further, the Commissioner was authorized to charge the associated fees of:

- (a) \$500.00 for the filing of the original filing of the Appeal Brief; and
- (b) \$450.00 for the Petition For Extension Of Time

to deposit account number 19-0733. It is believed that no additional fees are due in connection with this Appeal Brief. Should additional fees be deemed necessary, however, such fees are

hereby requested and the Commissioner is authorized to charge deposit account number 19-0733
for the payment of the requisite fees.

Respectfully submitted,

By: 
Thomas L. Evans
Registration No. 35,805

Banner & Witcoff, Ltd.
1001 G Street, N.W.
Washington, D.C. 20001-4597
Telephone: (202) 824-3000

Dated: September 15, 2005

CLAIMS APPENDIX

1. (Withdrawn) A method of providing footwear, comprising:
receiving a request from a customer for footwear;
determining at least one last associated with the customer for manufacturing the
footwear; and
providing the customer with the footwear after the footwear has been manufactured with
the at least one last.
2. (Withdrawn) The method of providing footwear recited in claim 1, wherein the request
identifies the last associated with the customer.
3. (Withdrawn) The method of providing footwear recited in claim 1, wherein
the request provides an identity for the customer, and
the identity provided in the request is used to determine the last associated with the
customer.
4. (Withdrawn) The method for providing footwear recited in claim 1, further including
using the last to reform a shape of an interior of the footwear before providing the footwear to
the customer.
5. (Withdrawn) The method for providing footwear recited in claim 4, wherein the last is
used to reform a length of the interior of the footwear.
6. (Withdrawn) The method for providing footwear recited in claim 4, wherein the last is
used to reform a width of the interior of the footwear.
7. (Withdrawn) The method for providing footwear recited in claim 6, wherein the last is
used to also reform a length of the interior of the footwear.
8. (Withdrawn) The method for providing footwear recited in claim 1, further including
using the last to construct the footwear from material pieces.
9. (Withdrawn) The method for providing footwear recited in claim 1, further including
determining a first last associated with the customer for manufacturing a left shoe, and
determining a second last associated with the customer for manufacturing a right shoe; and
providing the customer with the footwear after the left shoe of the footwear has been
manufactured with the first last and the right shoe of the footwear has been manufactured with
the second last.
10. (Amended) A shoe distribution center, comprising:

an order receiving unit that receives orders from customers for footwear to custom fit the customer, each order identifying at least one last;

a footwear inventory containing a plurality of pieces of footwear in a variety of sizes, such that an interior of each piece of footwear incorporates a moldable fit-component that allows that piece of footwear to be remolded to lengths and widths differing from that piece of footwear's original lengths and widths; and

a footwear manufacturing unit for remolding lengths and widths of pieces of footwear in the footwear inventory using lasts identified in orders received by the order receiving unit.

11. (Original) The shoe distribution center recited in claim 10, wherein the footwear manufacturing unit includes:

a last inventory containing a plurality of lasts that can be used to remold lengths or widths of at least some of the pieces footwear in the footwear inventory; and

a heating unit for heating the lasts to remold lengths or widths of at least some of the pieces footwear in the footwear inventory.

12. (Original) The shoe distribution center recited in claim 10, wherein the order-receiving unit includes a server computer for receiving orders for custom fitting footwear over an electronic communication network.

13. (Original) The shoe distribution center recited in claim 10, wherein the order-receiving unit includes an automated voice menu system for receiving orders for custom fitting footwear over a telephone service.

14. (Original) The shoe distribution center recited in claim 10, further comprising:
a customer/last database containing one or more customer records, such that each record includes a customer field identifying a customer and at least one last field identifying a last associated with the customer.